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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/783,107      | 02/20/2004  | Masufumi Shimodaira  | KIN98USA            | 7687             |

270 7590 10/28/2005

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| EXAMINER |
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COLE, ELIZABETH M

|          |              |
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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/783,107

Applicant(s)

SHIMODAIRA ET AL.

Examiner

Elizabeth M. Cole

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/20/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

1. The amendment filed 5/24/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the insertion of the units for the thickness of the anti rewetting layer is not supported by the original disclosure. Applicant asserts in the remarks accompanying the amendment that both the error and its correction would be readily apparent to the skilled artisan, however, there is nothing on the record to support this assertion, (i.e., that the correct units would have to be microns).

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the structure of the claimed press felt is not clear because the order of the layers is not set forth, i.e., how the are layers oriented relative to each other.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Eklund, U.S. Patent No. 4,446,187. Eklund discloses a press felt comprising a reinforcement layer 3 which comprises a woven fabric having a nonwoven batt needled thereto and a foil layer formed from a thermoplastic film, (see col. 4, lines 30-51). The film has a plurality of holes or channels. See col. 4, lines 52-64. The channels can have a funnel shape. See figures 5-8. With regard to the limitation that the film is non-oriented, Eklund is silent as to whether the film is oriented and therefore it is assumed that either it is not oriented or that the disclosure of Eklund encompasses both oriented and non-oriented films.

5. Claims 1, 5-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press having excellent rewetting suppression comprising a base layer, batt layers and a rewetting prevention layer. The layers are bonded by needling. See paragraph 0028. the rewetting prevention layer comprises a thin film. See paragraph 003. The film is perforated by needling punching. The perforation process produces holes having a three dimensional structure wherein the perforations have a funnel shape. See paragraphs 0034, 0045, 0048, and 0053, as well as figure 3. the layer can also have planar openings in addition to the three-dimensional openings. See claim 2. Watanabe teaches the use of nylon films as the rewetting prevention layer. See paragraph 0035.

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With regard to the limitation that the rewetting prevention layer is non-oriented, it is noted that while Watanabe teaches that biaxially oriented films are "suitable" for use, Watanabe also generically teaches the use of films as the rewetting prevention layer. Further, Watanabe teaches that using a biaxially oriented film prevents splitting of the of the film during the needling process, and therefore Watanabe implicitly teaches that using unoriented films is less preferred, but known. See paragraph 0049. Finally, it is noted that Watanabe's claims are not limited to an oriented film.

6. Claims 1, 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press felt as set forth in the preceding paragraph.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3 rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press felt as set forth above.

Watanabe does not disclose the claimed elongation at break, however, since Watanabe discloses the same structure and the same materials, presumably the film of Watanabe would inherently have the claimed elongation at break.

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9. Claims 2-3 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press felt as set forth above.

Watanabe does not disclose the claimed elongation at break, however, since Watanabe discloses the same structure and the same materials, presumably the film of Watanabe would inherently have the claimed elongation at break.

10. Claims 3-4, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eklund, U.S. Patent No. 4,446,187 in view of Gulya et al, U.S. Patent No. 5,071,697.

Eklund discloses a press felt as set forth above. Eklund differs from the claimed invention because Eklund does not disclose employing a nylon layer as the rewetting prevention layer. Gulya teaches at col. 2 lines 56-61, that nylon films are equivalent to the polyurethane films employed in Eklund for the purpose of forming a rewetting prevention layer in a press felt. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a nylon layer instead of a polyurethane layer as the rewetting prevention layer of Eklund, motivated by the teaching of Gulya that the two types of films were recognized as equivalents in the art. With regard to the claimed elongation at break, either the nylon layer of Gulya would inherently possess the claimed elongation at break, or else it would have been obvious to have selected the film composition, thickness, etc., so that it had the desired strength.

11. With regard to claims 7-8, Eklund differs from the claimed invention because Eklund does not specifically disclose flat openings in addition to the three dimensional

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openings. However, Eklund teaches that the openings can have any configuration.

See col. 3, lines 39-56. Therefore, it would have been obvious to one of ordinary skill in the art to have selected the shape and depth of the openings through the process of routine experimentation as taught by Eklund in order to form a press felt having the optimum rewetting prevention characteristics.

12. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eklund. Eklund discloses a press felt as set forth above. Eklund differs from the claimed invention because Eklund does not specifically disclose flat openings in addition to the three dimensional openings. However, Eklund teaches that the openings can have any configuration. See col. 3, lines 39-56. Therefore, it would have been obvious to one of ordinary skill in the art to have selected the shape and depth of the openings through the process of routine experimentation as taught by Eklund in order to form a press felt having the optimum rewetting prevention characteristics.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

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A handwritten signature in black ink, appearing to read "Elizabeth M. Cole". The signature is fluid and cursive, with the first name "Elizabeth" written in a larger, more prominent script than the last name "Cole".

Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

e.m.c